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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,325	06/02/2000	Guy Nathan	871-83	7170

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,325

Applicant(s)

NATHAN ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/2004 has been entered.

Response to Amendment

2. Amendment C, paper # 16, received on 2/24/2004 is acknowledged and entered. Claims 15, 19-21, 23 and 28 are amended and new claims 29-30 have been added. Currently claims 15-30 are pending for examination.

Response to Arguments

3. Applicant's arguments (see pages 7-9 of amendment C) filed on 2/24/2004 concerning claims 15-28 have been fully considered but they are not persuasive for following reasons:

(i) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "specific destination equipment" and "the user's terminal not being the destination equipment" on page 7 lines 18-20 and "(a location other than directly at the jukebox)" on page 8, lines 9-10 ", " a

location other than the jukebox itself on page 8, line 13 and "order its executionon another jukebox" on page 8, line 17) are not recited in the rejected claim(s). Claims merely specify "one destination equipment" and do not specify that this destination equipment has to be categorically a specific destination equipment or a location other than directly at the jukebox or not being the user's terminal. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(ii) The applicant argues (on page 8 of the amendment C) that neither Nathan or Kleiman suggests or teaches enabling the user to select, in advance, via the user's terminal a song and order it so that the song can be played on a given date on a given juke box or on a several given jukeboxes. The examiner respectfully does not agree as Nathan does anticipate this teaching, see col.8, line 60-col.9, line 14, *"Another feature of the reproduction system according to the invention is to enable a particular song to be played at a defined time simultaneously on at least one determined reproduction system. For example, this feature may be used to promote a new album or a concert given by a singer. For example, this feature could be used to play the title song of a singer's new album on all reproduction systems, on the day that it is distributed in the shops. This feature can also be used to distribute a song by this singer on reproduction systems located close to the location at which a concert given by the singer will shortly be held. Playing a particular song at a particular moment on at least one particular reproduction system is initiated by a series of orders contained in a file located on each audiovisual reproduction system. The orders contained in the file determine which song should be played and the moment(s) at which it should be played. Advantageously, the file containing orders for execution of the particular song at a particular moment is downloaded on each reproduction system concerned through the host server and the distribution network. The orders contained in the file will be executed when the audiovisual reproduction system reads this file."*

(iii) The applicant argues (see pages 8-9 of the amendment C) that "Applicants respectfully do not acquiesce on the Official Notice taken in the Office Action with respect to various elements. It is respectfully submitted that in order to establish that such elements are

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well known, some teaching in the prior art must cited to support the Official Notice in the Office Action". The examiner respectfully disagrees, as the applicant has not indicated any errors or deficiencies with the Official Notices taken by the examiner. See MPEP 2144.03 C " *If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.").If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. "* In view of the MPEP guidelines and in absence of pointing out any errors with the Official Notice taken by the examiner the common knowledge or well-known art used as Official Notice by the examiner in the previous Office is taken as admitted prior art.

In view of the foregoing, rejection of claims 15-28 is maintained as being unpatentable over Nathan and further in view of Kleiman.

Claim Rejections - 35 USC § 103

4 Claims 15-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan (US Patent 6,336,219) and further in view of Kleiman (US Patent 5,959,945).

Nathan teaches the claimed limitations of claims 15-28, that is a method, device and system where a jukebox and a server can communicate with each other and receive messages

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and store them, display the identity of the destination equipment, receive the selection from a user's terminal connected to the host server via a communication network to be played on the destination equipment capable of being connected via the communication network to the host server, special requests are recorded and downloaded on a file, execution of the request at a given time and date, making payments, (at least see, abstract, FIG.1. Note: Fig.1 which represents the electrical scheme of Patent '219 is similar to that displayed in the Fig.1 of the claimed invention, abstract, col.1, lines 15-38, col.1, line 66-col.2, line 24, col.4, lines 63-67, col.8, line 9-col.10, line 22. Note: Nathan's teaching of "enable a particular song to be played at a defined time ", relates to play the selected/requested in advance songs at a later date at the destination equipment). Nathan, further, teaches to record a voice message to be played before the song to be played (see at least col.6, lines 7-16, "*..The IRM modulereproduction of complete selectionsspoken promotional announcements of new musical selections....*". Note: just like these spoken promotional announcements voice messages can be recorded and played before playing of the songs. Also, see col.8, line 60-col.9, line 14, "*Another feature of the reproduction system according to the invention is to enable a particular song to be played at a defined time simultaneously on at least one determined reproduction system. For example, this feature may be used to promote a new album or a concert given by a singer. For example, this feature could be used to play the title song of a singer's new album on all reproduction systems, on the day that it is distributed in the shops. This feature can also be used to distribute a song by this singer on reproduction systems located close to the location at which a concert given by the singer will shortly be held. Playing a particular song at a particular moment on at least one particular reproduction system is initiated by a series of orders contained in a file located on each audiovisual reproduction system. The orders contained in the file determine which song should be played and the moment(s) at which it should be played. Advantageously, the file containing orders for execution of the particular song at a particular moment is downloaded on each reproduction system concerned through the host server and the distribution network. The orders contained in the file will be executed when the audiovisual reproduction system reads this file. ".)*).

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Nathan also teaches that the operating software is built up around a library of tools and services (see at least col.5, lines 17-27) and these tools and services may well include C++ language using OOP-Object oriented programming methodology. C++ language and OOP-object oriented programming methodology was well-known tools at the time of the invention to be used and applied to a messaging interface of an electronic messaging system such that a set of OOP classes and objects for the messaging interface can be provided.

Nathan does not show ordering in advance selected songs for an event and that the communication network is Internet. However, Kleiman, in the same field of distributing music to a plurality of Jukeboxes, teaches ordering in advance selected songs for an event and teaches that the communication network is Internet (at least see, col.4, lines 21-59, "*... A music hierarchy system exists in the juke box for determining customer preferences...It is further object of the present invention to provide...with music on demand andmusic based on local user needs at deferred times ...*"). Note: customer preferences and music on demand based on local user needs at deferred times in Kleiman relate to customer's selection and ordering in advance for a desired event as claimed in the application. Also, see col.5, line 60-col.8, line 67, col.9, line 59-col.10, line 17. As regards the use of Internet, see col. 3, lines 42-44, "*Songs may be transferred through the Internet*"). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan to include the concept of ordering in advance selected songs for an event and transferring the songs via Internet, as shown in Kleiman. Doing so would help the users to enable a particular selection of songs to be played at a remote destination at a defined time, as suggested in both Nathan (col.8, lines 60-63) and Kleiman (col.4, lines 37-40).

Nathan/Kleiman does not teach displaying a list of events and selecting an event. Official Notice is taken of both the concepts and benefits of displaying a list of events and to selecting an event in the field of events related to social expressions like, bridal shower, baby shower,

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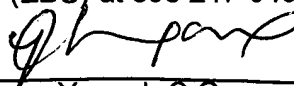
wedding, birthday, funerals, graduation, anniversary events enabling the user to select one of them and then making it convenient and easy to choose the item, like greeting card, gift, for that event. It would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan/Kleiman to include the feature of displaying a list of events and selecting an event for playing a selection of songs. Doing so would make it convenient and easier for the user, when selecting greeting cards and gifts, to select the songs as per his preference and required by the occasion.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Examiner
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YCG

March 21, 2004.